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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,952	10/22/2003	Michael J. Wookey	30014200-1103	6437
26263	7590	08/22/2006	EXAMINER	
SONNENSCHN NATH & ROSENTHAL LLP			BONURA, TIMOTHY M	
P.O. BOX 061080			ART UNIT	
WACKER DRIVE STATION, SEARS TOWER			PAPER NUMBER	
CHICAGO, IL 60606-1080			2114	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,952

Applicant(s)

WOOKEY, MICHAEL J.

Examiner

Tim Bonura

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-19, 21-35 and 37-49 is/are rejected.
- 7) ☒ Claim(s) 4, 20 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

- **Claims 1-2, 8, 10-11, 17-18, 24, 26-27, 33-34, 40, 42-43 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Tryon, III, et al, U.S. Patent Number 7,006,947.**
- **Claim 3, 5-7, 9, 12-16, 19, 21-23, 25, 28-32, 35, 37-39, 41, and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tryon, III, et al, U.S. Patent Number 7,006,947 as applied to claims 1, 17, and 33 above, and further in view of Ali, et al, U.S. Patent Number 7,036,049.**
- **Claims 17-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter**
- **Claims 1-2, 17-18, and 33-34 provisionally rejected on the ground of nonstatutory obviousness-type double patenting**
- **Claim 4, 20, and 36 objected to as being dependent upon a rejected base claim**

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-2, 8, 10-11, 17-18, 24, 26-27, 33-34, 40, 42-43 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Tryon, III, et al, U.S. Patent Number 7,006,947.**
3. Regarding claim 1:

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- a. Regarding the limitation of “asynchronously receiving information about a computer-based system,” Tryon discloses a system that can gather data in a variable fashion. (Lines 19-23 of Column 3 and Lines 5-10 of Column 4).
  - b. Regarding the limitation of “calculating an exposure level to failure of the computer-based system based on the received information,” Tryon disclose a system wherein an instruction is used to measure the collected data and to create a prediction of failure of the system. (Lines 20-25 of Column 3).
4. Regarding claim 2, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).
5. Regarding claim 8, Tryon disclose that the method of failure prediction is a computer implemented computer program product. (Lines 27-31 of Column 3).
6. Regarding claim 10, Tryon discloses that the results are communicated across a data path to a user interface. Thereby the transmission of the data is a across a network to the user interface. (Lines 24-25 of Column 3 and Lines 33-40 of Column 10). Tryon discloses a system wherein the data transmitted comes from the CPU that created the prediction to failure calculation. (Lines 23-33 of Column 10).
7. Regarding claim 11, Tryon discloses a system with means for collecting data from hardware sensors. (Lines 9-12 of Column 10).
8. Regarding claim 17:
  - c. Regarding the limitation of “asynchronously receiving information about a computer-based system,” Tryon discloses a system that can gather data in a variable fashion. (Lines 19-23 of Column 3 and Lines 5-10 of Column 4).
  - d. Regarding the limitation of “calculating an exposure level to failure of the computer-based system based on the received information,” Tryon disclose a system

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wherein an instruction is used to measure the collected data and to create a prediction of failure of the system. (Lines 20-25 of Column 3).

9. Regarding claim 18, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

10. Regarding claim 24, Tryon disclose that the method of failure prediction is a computer implemented computer program product. (Lines 27-31 of Column 3).

11. Regarding claim 26, Tryon discloses that the results are communicated across a data path to a user interface. Thereby the transmission of the data is a across a network to the user interface. (Lines 24-25 of Column 3 and Lines 33-40 of Column 10). Tryon discloses a system wherein the data transmitted comes from the CPU that created the prediction to failure calculation. (Lines 23-33 of Column 10).

12. Regarding claim 27, Tryon discloses a system with means for collecting data from hardware sensors. (Lines 9-12 of Column 10).

13. Regarding claim 33:

e. Regarding the limitation of "a memory comprising a program that asynchronously receiving information about a computer-based system," Tryon discloses a system that can gather data in a variable fashion. (Linens 19-23 of Column 3 and Lines 5-10 of Column 4).

f. Regarding the limitation of "calculates an exposure level to failure of the computer-based system based on the received information," Tryon disclose a system wherein an instruction is used to measure the collected data and to create a prediction of failure of the system. (Lines 20-25 of Column 3).

14. Regarding claim 34, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

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15. Regarding claim 40, Tryon disclose that the method of failure prediction is a computer implemented computer program product. (Lines 27-31 of Column 3).

16. Regarding claim 42, Tryon discloses that the results are communicated across a data path to a user interface. Thereby the transmission of the data is a across a network to the user interface. (Lines 24-25 of Column 3 and Lines 33-40 of Column 10). Tryon discloses a system wherein the data transmitted comes from the CPU that created the prediction to failure calculation. (Lines 23-33 of Column 10).

17. Regarding claim 43, Tryon discloses a system with means for collecting data from hardware sensors. (Lines 9-12 of Column 10).

18. Regarding claim 49:

g. Regarding the limitation of "means for asynchronously receiving information about a computer-based system," Tryon discloses a system that can gather data in a variable fashion. (Lines 19-23 of Column 3 and Lines 5-10 of Column 4).

h. Regarding the limitation of "means for calculating an exposure level to failure of the computer-based system based on the received information," Tryon disclose a system wherein an instruction is used to measure the collected data and to create a prediction of failure of the system. (Lines 20-25 of Column 3).

### ***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claims 3, 5-7, 9, 12-16, 19, 21-23, 25, 28-32, 35, 37-39, 41, and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tryon, III, et al, U.S. Patent Number 7,006,947 as applied to claims 1, 17, and 33 above, and further in view of Ali, et al, U.S. Patent Number 7,036,049.

22. Regarding claim 3, Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for calculating the confidence level of the exposure level. However, Ali teaches of a system that a calculation is performed to determine the severity of the fault condition and raises an alarm level each time a threshold value is crossed. (Lines 20-40 of Column 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

23. Regarding claim 5, Ali discloses a method of calculating severity of failure wherein the severity increase when a threshold value is crossed. (Lines 33-40 of Column 11).

24. Regarding claim 6, Tryon discloses a system that can gather data in a variable fashion. (Lines 19-23 of Column 3 and Lines 5-10 of Column 4). Tryon discloses a method with a first

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order reliability method. (Lines 60-61 of Column 6). Tryon discloses a system wherein the calculation are used to determine the level at which the system is about to fail. (Lines 10-16 of Column 3, see Figure 5F also).

25. Regarding claim 7, Tryon discloses a method with a first order reliability method. (Lines 60-61 of Column 6). Tryon discloses a method with multiple rules methods for calculation the prediction to failure. (Lines 59-65 of Column 6).

26. Regarding claim 9, Tryon teach of a system that can collect information from a system to deter a system response. Tryon does not teach a system of subscribing to the information to be collected. Ali discloses a system that teaches of polling information after send periodic requests to the statistical collection units. (Lines 25-30 of Column 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the collection polling of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the polling system of the statistics collection units during scheduled polling periods. (Lines 25-30 of Column 5).

27. Regarding claim 12, Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for calculating the difficulty value for reducing the exposure level. However, Ali teaches of a system that a calculation is performed to determine the severity of the fault condition and raises an alarm level each time a threshold value is crossed. (Lines 20-40 of Column 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-



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35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

28. Regarding claim 13, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

29. Regarding claim 14, Ali discloses a system in which the system faults result in loss of revenue. (Lines 10-13 of Column 6).

30. Regarding claim 15, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

31. Regarding claim 16, Tryon discloses a method with a second order reliability method. (Lines 60-61 of Column 6). Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for trending of the risk level and the second risk level. However, Ali teaches of a system calculating a two risk levels (integrity and collection errors) and to use that information to calculating a percentage of error over time periods to assess the risk to the system. (Lines 64-67 of Column 7 and Line 45-63 of Column 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

32. Regarding claim 19, Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for calculating the confidence level of the exposure level. However, Ali teaches of a system that a calculation is performed to determine the severity of the fault condition and raises an alarm level each time a threshold

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value is crossed. (Lines 20-40 of Column 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

33. Regarding claim 21, Ali discloses a method of calculating severity of failure wherein the severity increase when a threshold value is crossed. (Lines 33-40 of Column 11).

34. Regarding claim 22, Tryon discloses a system that can gather data in a variable fashion. (Lines 19-23 of Column 3 and Lines 5-10 of Column 4). Tryon discloses a method with a first order reliability method. (Lines 60-61 of Column 6). Tryon discloses a system wherein the calculation are used to determine the level at which the system is about to fail. (Lines 10-16 of Column 3, see Figure 5F also).

35. Regarding claim 23, Tryon discloses a method with a first order reliability method. (Lines 60-61 of Column 6). Tryon discloses a method with multiple rules methods for calculation the prediction to failure. (Lines 59-65 of Column 6).

36. Regarding claim 25, Tryon teach of a system that can collect information from a system to deter a system response. Tryon does not teach a system of subscribing to the information to be collected. Ali discloses a system that teaches of polling information after send periodic requests to the statistical collection units. (Lines 25-30 of Column 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the collection polling of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the polling

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system of the statistics collection units during scheduled polling periods. (Lines 25-30 of Column 5).

37. Regarding claim 28, Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for calculating the difficulty value for reducing the exposure level. However, Ali teaches of a system that a calculation is performed to determine the severity of the fault condition and raises an alarm level each time a threshold value is crossed. (Lines 20-40 of Column 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

38. Regarding claim 29, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

39. Regarding claim 30, Ali discloses a system in which the system faults result in loss of revenue. (Lines 10-13 of Column 6).

40. Regarding claim 31, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

41. Regarding claim 32, Tryon discloses a method with a second order reliability method. (Lines 60-61 of Column 6). Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for trending of the risk level and the second risk level. However, Ali teaches of a system calculating a two risk levels (integrity and collection errors) and to use that information to calculating a percentage of error over time periods to assess the risk to the system. (Lines 64-67 of Column 7 and Line 45-63 of

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Column 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

42. Regarding claim 35, Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for calculating the confidence level of the exposure level. However, Ali teaches of a system that a calculation is performed to determine the severity of the fault condition and raises an alarm level each time a threshold value is crossed. (Lines 20-40 of Column 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

43. Regarding claim 37, Ali discloses a method of calculating severity of failure wherein the severity increase when a threshold value is crossed. (Lines 33-40 of Column 11).

44. Regarding claim 38, Tryon discloses a system that can gather data in a variable fashion. (Lines 19-23 of Column 3 and Lines 5-10 of Column 4). Tryon discloses a method with a first order reliability method. (Lines 60-61 of Column 6). Tryon discloses a system wherein the calculation are used to determine the level at which the system is about to fail. (Lines 10-16 of Column 3, see Figure 5F also).

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45. Regarding claim 39, Tryon discloses a method with a first order reliability method. (Lines 60-61 of Column 6). Tryon discloses a method with multiple rules methods for calculation the prediction to failure. (Lines 59-65 of Column 6).

46. Regarding claim 41, Tryon teach of a system that can collect information from a system to deter a system response. Tryon does not teach a system of subscribing to the information to be collected. Ali discloses a system that teaches of polling information after send periodic requests to the statistical collection units. (Lines 25-30 of Column 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the collection polling of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the polling system of the statistics collection units during scheduled polling periods. (Lines 25-30 of Column 5).

47. Regarding claim 44, Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for calculating the difficulty value for reducing the exposure level. However, Ali teaches of a system that a calculation is performed to determine the severity of the fault condition and raises an alarm level each time a threshold value is crossed. (Lines 20-40 of Column 11). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the errors have caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

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48. Regarding claim 45, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

49. Regarding claim 46, Ali discloses a system in which the system faults result in loss of revenue. (Lines 10-13 of Column 6).

50. Regarding claim 47, Tryon discloses a system wherein the predicted results are communicated to a user and displayed. (Lines 35-51 of Column 10).

51. Regarding claim 48, Tryon discloses a method with a second order reliability method. (Lines 60-61 of Column 6). Tryon teaches calculating the probabilistic analysis to determine the variation in the system response. Tryon does not teach a system for trending of the risk level and the second risk level. However, Ali teaches of a system calculating a two risk levels (integrity and collection errors) and to use that information to calculating a percentage of error over time periods to assess the risk to the system. (Lines 64-67 of Column 7 and Line 45-63 of Column 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the failure prediction of Tryon with the severity of failure of Ali. One would have been inclined to combine the art because Tryon teaches of a need for more accurate prediction of failure use mathematical analysis. (Lines 30-35 of Column 4). Ali fulfils the need by using the error log to determine if the error has caused a failure to cross the threshold to the next level of severity. (Lines 33-40 of Column 11).

### ***Claim Rejections - 35 USC § 101***

52. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

53. Claims 17-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims, 17-32 recites a computer readable

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medium. The specification discloses computer readable medium being able to exist in a non-statutory state of a carrier wave (Page 10 of the spec. quoted below)

- i. "aspects may be stored on or read from other computer-readable media, such as secondary storage devices, like hard disks, floppy disks, and CD-ROM; a carrier wave received from a network such as the Internet; or other forms of ROM or RAM either currently known or later developed" (underline by examiner).

54. These claims therefore are interpreted as recording a program per se. In order to overcome this rejection, language, specifically stating the claim, must be limited to a computer program stored on a computer recordable medium executing on a computer.

### ***Double Patenting***

55. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

56. Claim 1 of U.S. patent application number 10/690952 contain(s) every element of claims 1 and 2 of the instant application and as such anticipate(s) claim 1 and 2 of the instant application.

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57. Claim 11 of U.S. patent application number 10/690952 contain(s) every element of claims 17 and 18 of the instant application and as such anticipate(s) claim 17 and 18 of the instant application.

58. Claim 22 of U.S. patent application number 10/690952 contain(s) every element of claims 33 and 34 of the instant application and as such anticipate(s) claim 33 and 34 of the instant application.

59. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001)

60. Claims 1-2, 17-18, and 33-34 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 11 and 22 (respectively) of copending Application No. 10/690,951. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention to anticipate that claims 1 and 2 of the present application in view of in re Goodman.

61. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



***Allowable Subject Matter***

62. Claim 4, 20, and 36 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

63. The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 4, 20, and 36, the prior art of record fails to teach singly or in combination with another prior art the limitations of "risk level = exposure level \* confidence level / a mitigating factor, where the mitigating factor is a value associated with the computer-based system".

***Conclusion***

64. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tim Bonura**.

- The examiner can normally be reached on **Mon-Fri: 8:30-5:00**.
- The examiner can be reached at: **571-272-3654**.

65. If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, **Scott Baderman**.

- The supervisor can be reached on **571-272-3644**.

66. The fax phone numbers for the organization where this application or proceeding is assigned are:

- **703-872-9306 for all patent related correspondence by FAX.**

67. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

68. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is: **571-272-2100**.

69. Responses should be mailed to:

- **Commissioner of Patents and Trademarks**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

Tim Bonura  
Patent Examiner  
Art Unit 2114

A handwritten signature in black ink, appearing to read 'Tim Bonura', with a stylized flourish at the end.

tmb  
August 19, 2006